

REMARKS

Remaining in the case is Claim 26 with dependent Claims 27, 28, 29, 31 and 42; Claim 32 with dependent Claims 34, 35, 37 and 38; and Claims 43 with dependent Claims 44, 45, 46, 47, 48 and 49.

The claims as previously presented have been rejected by Examiner Wilson under 35 U.S.C. § 112 on the grounds that the claims include language as follows: “Causing filler material and said shaft distal portion to fill the root canal or optionally to allow said shaft to be removed” and that this is new matter that was not part of the original disclosure. Examiner Wilson’s position is correct and accordingly this language has been removed from all subsisting claims or more specifically, the claims have been amended so that this language is removed.

Further, Examiner Wilson rejected the claims under 35 U.S.C. § 103 as being unpatentable over Malmin, McSpadden, Crovatto and Ruddle.

The claims remaining define the invention best illustrated in Figure 10 of the drawings of the application and as described on Pages 16 and 17 of the specification. The claims as rewritten define a unique concept in which a method of filling an endodontically prepared root canal of a tooth includes the steps of applying filler material to the external surface of a distal portion of an elongated structural shaft, inserting the proximal portion of the shaft having filler material thereon into the root canal and applying a beam of energy to the shaft to heat the shaft and cause a surface tension of the filler material to substantially decrease to cause the filler material to fill the root canal and allow the shaft to be removed leaving the filler material in the root canal. This is specifically illustrated and described in the drawings and specification and is not taught nor suggested by any of the referenced prior art patents. Specifically, none of the patents to Malmin, McSpadden, Crovatto or Ruddle teach the concepts of heating a shaft by the application of

radiant energy. Malmin as an example, teaches vibrating the shaft in which a physical instrument extends within the root canal and into the filler material within the canal, and by which energy is applied directly from the instrument to the filler material. Applicant's invention is specifically contrary to Malmin in that a physical instrument employed to convey energy to decrease the surface tension of the filler material is not utilized. Instead, a beam of energy, such as sound energy or electromagnetic energy, is guided to the shaft to heat the shaft while in the root canal to decrease the surface tension and to allow the shaft to be removed leaving the filler material within the root canal. Since this concept is not taught in the cited references the claims remaining in the case should be expeditiously allowed.

Examiner Wilson has also raised the issue of double patenting which has previously been raised. In response to the double patenting issue a terminal disclaimer has been filed herein. Examiner Wilson says that "the terminal disclaimer does not comply with 37 C.F.R. 1.321(b) or (c) because the person who has signed the disclaimer has not stated the extent of his or her interest, or the business entity's interest, in the application/patent," citing 37 C.F.R. 1.321(b). The terminal disclaimer that was executed on November 3, 2004, specifically states that "the inventor, Ralph C. Mays, by and through his attorney of record, in the instant application, hereby disclaims..." The disclaimer is executed by Paul H. Johnson, attorney of record in the case. Thus the disclaimer is by the Applicant's attorney of record. Therefore it is not understood why Examiner Wilson states that "the person who signed the Disclaimer has not stated the extent of his/her interest or the business entity's interest in the application/patent." Therefore, it is respectfully requested that the Terminal Disclaimer be accepted to overcome the objection to the claims because of "double patenting."

A serious effort has been made to place the application in condition for allowance which is respectfully requested.

The Commissioner is hereby authorized to debit any additional fees which might be due under 37 C.F.R. 1.16 or 1.17 to undersigned's Deposit Account No. 50-1971.

Respectfully submitted,



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